

## **REMARKS**

Claims 1-2, 5-13, 15 and 18 are pending in this application, with claims 20-25 withdrawn from consideration. Attached hereto is a complete listing of all claims in the application, with their current status listed parenthetically. By this Response, claims 1, 5, 7, 15 and 18 are amended, and are presented with markings indicating their current amendments.

### **Objection to the Specification**

In paragraph 1 of the Office Action, the Examiner objects to the disclosure in paragraph 0024 as grammatically incorrect. In response, Applicant has corrected the grammatical error.

In paragraph 2 of the Office Action, the Examiner objects to the disclosure as failing to provide proper antecedent basis for "a lip opposite the base." In response, Applicant has amended paragraph 0025 to provide proper antecedent basis, and notes that support for this amendment can be found in originally-filed claims 4 and 23 and in FIGS. 1-3 and 6-7.

### **Rejection Under 35 U.S.C. § 112, 2nd paragraph**

In paragraph 3 of the Office Action, the Examiner rejects claims 1, 2, 5-13 and 15 as being indefinite. Specifically, the Examiner notes that claims 5 and 15 depend from cancelled claims 4 and 14, respectively. In response, Applicant has amended claims 5 and 15 to now depend from claim 1.

The Examiner then states:

"Wherein the body of claim 1 positively recites the container structure, the claims are considered to be drawn to the combination of the container and adaptor. Thus, the preambles of the claims are inconsistent with the recited claimed structure. The preambles should be rewritten to reflect the claimed structure includes [sic] both the container and adaptor. The structure of the cap is not clearly set forth in the claims. How is the lip opposite the base? What is the structure of the cap?"

In an effort to provide a clear and non-ambiguous prosecution history, Applicant firmly responds that the pending claims, and specifically, independent claims 1 and 18 are **not** drawn to a "combination of the container and adaptor." Therefore, the preambles are not inconsistent with the recited claim structure. The preambles recite the intended use of the **adaptor**, which is the only apparatus being claimed. M.P.E.P. § 2111.02 II states:

"The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966 (M.P.E.P. § 2111.02 II)

A review of the specification shows that the inventors invented a "sip adaptor" (paragraph 0002). The Brief Description of the Drawings describe various embodiments of a "sip cup adaptor." One embodiment of the adaptor can be used with a conventional paper cup, but other embodiments may be used with other types of containers used for holding consumable fluids.

The intended use of one embodiment of the "sip cup adaptor" is with a cup having a bead, and thus the preamble to claim 1 recites that intent. However, to more clearly recite the invention, Applicant has amended the preambles of independent claims 1 and 18 to more clearly recite an adaptor only (claim 18), and in claim 1, limited reference to only elements of a cup necessary to eliminate the possibility of any ambiguity.

The Examiner then states that "[t]he structure of the cap is not clearly set forth in the claims. How is the lip opposite the base? What is the structure of the cap?"

Regarding the "structure of the cap," a reading of claim 1 reveals that the cap has an aperture, and "an annular base depending from the cap . . . and further comprising a lip opposite the base" that defines "a portion of the recess to more fully enclose the bead of the cup."

Regarding "how the lip is opposite the base" is addressed by the recited structure of "a lip opposite the base" that defines "a portion of the recess to more fully enclose the bead of the cup."

Applicant notes that "breadth of a claim is not to be equated with indefiniteness. . . If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." M.P.E.P. § 2173.04

Applicant submits that with the amendments to the claim preambles, the scope of the claims is now clear, and sufficient structure is recited in the claims to clearly define the invention.

The above-described claim amendments have been drafted in response to the indefiniteness rejection, to impart precision into the claims by more particularly pointing out the invention. The claim amendments have not been drafted to overcome any prior art.

In view of the above, Applicant respectfully requests that the Examiner reconsider and withdraw these rejections.

### **Rejection Under 35 U.S.C. § 102**

Pending claim 18 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,216,865 ("Dickover"). As discussed below, Applicant respectfully traverses this rejection.

#### **A. The Law of Anticipation and Enabling Prior Art References**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Id.*

However, Applicant submits that claim 18 has elements that cannot be found, either expressly or inherently, in Dickover. For example, claim 18 recites, in part, "a cap having an aperture sized to pass a drinkable fluid."

Dickover has no teaching or suggestion of a cap having an aperture sized to pass a drinkable fluid. Instead, Dickover teaches a battery vent closure for "self-sealing closures for storage battery service" (col. 1, lines 12-13). Dickover further teaches that "[i]n the use of the improved battery closure, the workman opens the lid 15 to test or fill the battery" (col. 4, lines 42-43). Dickover fails to teach or suggest using his battery vent closure for passing a drinkable fluid.

Accordingly, Applicant respectfully submits that Dickover cannot anticipate claim 18, and Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

#### **1<sup>st</sup> Rejection Under 35 U.S.C. § 103(a)**

In paragraph 6 of the Office Action, claims 1, 2, 5-11 and 15 stand rejected as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 3,120,912 ("Mount"). Applicant respectfully traverses this rejection.

The Examiner states:

"Mount teaches an adaptor comprising a cap having an aperture, and annular base, a recess and a container therefore. Mount teaches the adaptor and container have a snap-fit engagement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute screw threads for the snap bead of Mount since the examiner takes Official Notice of the equivalence of snap-fit engagement and threaded engagement for their use in the closure art and the selection of any of these known equivalents to secure a closure to a container would be within the level of ordinary skill in the art."

In response, Applicant respectfully traverses the Examiners assertions relating to her Official Notice and requests a reference in support of her position. M.P.E.P. § 2144.03

The Examiner is invited to review Applicant's May 9, 2006, Response that discussed Mount. Specifically, in addition to not teaching threading engagement, Mount also fails to teach "a lip opposite the base and defining a portion of the recess to more fully enclose the bead of the cup."

In view of the above, Applicant respectfully submits that the above discussion has traversed the rejection of independent claim 1. Because claims 2, 5-11 and 15 depend from claim 1, it is respectfully submitted that the rejection of claims 2, 5-13 and 15 has been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

**2nd Rejection Under 35 U.S.C. § 103(a)**

In paragraph 7 of the Office Action, claims 12 and 13 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Mount in view of Dickover. Applicant respectfully traverses this rejection.

Because claims 12 and 13 depend from independent claim 1, and this independent claim have been distinguished from Dickover above, it is respectfully submitted that the rejection of claims 12 and 13 have been traversed by virtue of their dependency from claim 1. M.P.E.P. § 2143.03.

**Conclusion**

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of claims 1-2, 5-13, 15 and 18 at an early date is solicited. No fee is believed due with this response. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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Date